

### **REMARKS**

Claims 8-13, 30-36, and 38-43 are currently pending. Claims 1-7, 14-29, and 37 have been withdrawn from consideration. Claims 8, 10-12, 33, and 40 have been amended. Applicants acknowledge and appreciate the Examiner's indication that claims 32 and 38 are allowable.

The Examiner has withdrawn claims 1-7, 14-29, and 37 from consideration believing they are drawn to a non-elected species. In the restriction mailed April 26, 2004, the Examiner noted three species, but never provided a description of the supposed differences or a suggestion as to which claims read on which species. Thus, it was left to Applicants to make this determination. While Applicants acknowledge and agree that there are three species illustrated in the figures, Applicants do not concede that all the species do not include a four-bar linkage. In fact, Applicants stated in the response to the restriction dated May 26, 2004 that "several of claims 1-43 are readable on two or more species identified by the Examiner." In addition, Applicants believe the species of Figs. 1-9, as well as the species of Figs. 11-14 include a four-bar linkage as that term would be understood by one of ordinary skill in the art.

The Examiner now states that the Applicants are incorrect in their determination of claims that read on the species of Figs. 1-9, and that Applicants made the election without traverse. This process denies the Applicants the opportunity to traverse the restriction of the claims, as the actual restriction is being presented after Applicants made the election. Had Applicants been presented with the Examiner's opinion at the time the Election was made, the Election would have been made with traverse.

The Examiner argues that the discussion of a four-bar linkage in relation to the species that includes Fig. 13 necessarily implies that the remaining species cannot contain a four-bar linkage. Based on this argument, the Examiner contends that any claim that includes the limitation of “a four-bar linkage” cannot read on the species of Figs. 1-9. This interpretation denies the reality that the species of Figs. 1-9 actually does include a four-bar linkage as that term would be understood by one of ordinary skill. The fact that Applicants chose not to explicitly describe the complete linkage of Figs. 1-9 as a four-bar linkage does not change the fact that the linkage is a four-bar linkage.

In support of Applicants’ contention that all of the species include a four-bar linkage, the Examiner is directed to the Declaration of Balaji Kandasami enclosed herewith. As stated by Mr. Kandasami, the term “four-bar linkage” is a term of art in mechanical engineering that would be clearly understood by one of ordinary skill in the art. A four-bar linkage is a mechanical linkage that includes a first link that rotates about a first axis, a second link that rotates about a second axis, a third link that interconnects the axes, and a fourth link that pivotally interconnects the free ends of the first and second links. A linkage that matches this description is clearly illustrated in Fig. 2 of the present application. A marked-up version of Fig. 2 is included with the Declaration of Mr. Kandasami to better illustrate the four-bar linkage. Thus, one of ordinary skill in the art would recognize that the construction of Figs. 1-9 includes a four-bar linkage. Furthermore, the description of the linkage included in the construction of Figs. 1-9 as a four-bar linkage would be unnecessary, as one of ordinary skill in the art would immediately recognize the linkage as a four-bar linkage. Thus, one of ordinary skill in the art, when reading claims 1-7, 14-29, and 37 would agree that the claims that include a four-bar linkage would read on the species illustrated in Figs. 1-9. Furthermore,

one of ordinary skill in the art would not interpret the discussion of a four-bar linkage in relation to Fig. 13 as limiting the remaining figures or implying the remaining figures do not show a four-bar linkage.

Thus, the proper analysis is to compare the limitations of the claims to the figures of the elected species to determine if the limitations of the claim are present in the species. It is not proper to limit the claims that read on one species based on the description of another species. In this case, it is clear that a four-bar linkage is present in the species of Figs. 1-9. As such, a claim that recites a four-bar linkage is not necessarily precluded from reading on the elected species of Figs. 1-9.

In light of the foregoing, Applicants respectfully request the reinstatement of claims 1-7, 14-29, and 37. In addition, Applicants request the substantive Examination of claims 1-7, 14-29, and 37.

The Examiner rejected claims 10-12 and 33 under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 8 has been amended to further clarify the orientation of the arcuate punching position and therefore, the orientation of the arcuate portion of the support portion. Claims 10-12 have been amended to conform to amended claim 8, thus better identifying the orientation angle of the support portion. Claim 33 has been amended to provide the paper tray with the proper antecedent basis. As such, Applicants request the withdrawal of the 35 U.S.C. §112 rejections.

The Examiner rejected claim 8 under 35 U.S.C. §102(b) as being anticipated by either Cavill (U.S. Patent No. 1,728,475) or Scharer (U.S. Patent No. 4,465,399).

Claim 8 defines a punch for punching at least one sheet of paper. The punch includes a base and a support portion. The support portion includes an arcuate portion configured to

support a first surface of the at least one sheet of paper in an arcuate punching position such that the paper curves at least partially around a generally vertical axis that is substantially perpendicular to the base. The punch also includes at least one punch mechanism operably associated with the support portion to punch at least one hole in the at least one sheet of paper upon actuation of the punch.

Cavill does not teach or suggest, among other things, a punch that includes an arcuate portion configured to support a first surface of the at least one sheet of paper in an arcuate punching position such that the paper curves at least partially around a generally vertical axis that is substantially perpendicular to the base. Rather, Cavill discloses a punch that includes a substantially horizontal support portion. The support portion includes a step in elevation that may produce a bend in a sheet of paper supported within the punch. However, the step does not include an arcuate portion *that supports* the paper in an arcuate punching position. Furthermore, even if the paper does bend, the orientation of the bend is not such that the paper bends at least partially around a vertical axis that is perpendicular to the punch base.

Scharer does not teach or suggest, among other things, a punch that includes an arcuate portion configured to support a first surface of the at least one sheet of paper in an arcuate punching position such that the paper curves at least partially around a generally vertical axis that is substantially perpendicular to the base. Rather, Scharer discloses a punch that includes a table 26 and a die plate 36. Both the table 26 and die plate 36 are substantially planar but are not parallel to one another. Thus, a sheet of paper positioned within the punch for punching may bend slightly. However, neither the table nor the die plate includes an arcuate portion. In fact, Scharer discloses no arcuate portion configured to support the paper in an arcuate punching position. In addition, the bend in the paper is not such that the paper

bends at least part way around a vertical axis that is substantially perpendicular to the punch base.

In light of the foregoing, neither Cavill nor Scharer teaches or suggests each and every limitation of claim 8. As such, claim 8 is allowable. In addition, claims 9-13 depend from claim 8 and are allowable for these and other reasons.

The Examiner rejected claims 30-31, 34-36, and 39 under 35 U.S.C. §102(b) as being anticipated by Land (U.S. Patent No. 4,294,152).

Claim 30 defines a punch that includes, among other things, a base and a support member pivotally coupled to the base and configured to support a sheet of paper. Land does not teach or suggest, among other things, a support member pivotally coupled to the base and configured to support a sheet of paper. The Examiner points to the head 54 of Land as the support member. However, the head 54 is not configured to support a sheet of paper. Furthermore, no other component of Land is pivotally coupled to the base and configured to support a sheet of paper.

In light of the foregoing, Land does not teach or suggest each and every limitation of claim 30. As such, claim 30 is allowable. In addition, claims 31, 34-36, and 39 depend from claim 30 and are allowable for these and other reasons.

The Examiner rejected claims 40-43 under 35 U.S.C. §102(b) as being anticipated by Walsh (U.S. Patent No. 3,590,484).

Claim 40 defines a method of punching a hole in a sheet of paper. The method includes supporting the sheet of paper in a punch position adjacent a punch mechanism using a support portion that is coupled to a stationary base and positioning a drive member in a drive position such that it is engageable with the punch mechanism. The method also includes

moving an actuator to move the drive member toward the sheet of paper and to move the sheet of paper toward the drive member.

Walsh does not teach or suggest, among other things, a method of punching a sheet of paper that includes supporting the sheet of paper in a punch position adjacent a punch mechanism using a support portion that is coupled to a stationary base. Rather, Walsh teaches a punch mechanism that requires the user to support the piece of paper during the punching operation. There is no support portion. In addition, the entire punch moves during a punching operation. Thus, there is no stationary base.

In addition, Walsh does not teach or suggest moving an actuator to move the sheet of paper toward the drive member. Rather, Walsh teaches a punch mechanism that is independent of the paper being punched. Actuation of the punch does not cause the paper to move. Rather, the punch ends 34 and 40 move toward one another until the paper is sandwiched therebetween and punched. Nothing in Walsh teaches or suggests moving the paper toward a drive member.

In light of the foregoing, Walsh does not teach or suggest each and every limitation of claim 40. As such, claim 40 is allowable. In addition, claims 41-43, which depend from claim 40 are allowable for these and other reasons.

The Examiner rejected claims 8-13 under 35 U.S.C. §103(a) as being unpatentable over Otsuka (U.S. Patent No. 3,921,487) in view of Murakami (U.S. Patent No. 5,494,364).

Claim 8 defines a punch for punching at least one sheet of paper. The punch includes a base and a support portion. The support portion includes an arcuate portion configured to support a first surface of the at least one sheet of paper in an arcuate punching position. The arcuate punching position is such that the paper curves at least partially around a vertical axis

that is substantially perpendicular to the base. The punch also includes at least one punch mechanism operably associated with the support portion to punch at least one hole in the at least one sheet of paper upon actuation of the punch.

Otsuka does not teach or suggest a punch that includes a punch portion that has an arcuate portion configured to support a sheet of paper in an arcuate punching position. In addition, Otsuka does not teach or suggest supporting a sheet of paper in an arcuate punching position that is such that the paper curves at least partially around a vertical axis that is substantially perpendicular to the base. The Examiner states that Otsuka includes a support portion made up of a perforated plate 8, a rod guide member 12, and a pair of sheet stack guide pieces 16. The Examiner also states that the guide member 12 includes an arcuate portion, but concedes that the arcuate portion does not support the sheet of material in an arcuate punching position.

Murakami does not cure the deficiencies of Otsuka. Murakami discloses a printer that includes a paper support member 800 that includes two substantially planar portions that are not parallel to one another. The support member 800 supports paper such that the paper bends away from the printer. Murakami does not teach or suggest an *arcuate* support portion that is configured to support a first surface of the at least one sheet of paper in an arcuate punching position. The arcuate punching position being such that the paper curves at least partially around a vertical axis that is substantially perpendicular to the base. The support member 800 of Murakami does not include an arcuate portion. In addition, the support portion 800 of Murakami does not curve the paper at least partially around a vertical axis. Rather, the paper curves around a horizontal axis.

To overcome the deficiencies of Otsuka and Murakami, the Examiner takes Official notice that having an arcuate support portion for supporting the sheet of paper in an arcuate punching position is not critical to the punching function and does not solve any stated problem. While Official notice is available to an Examiner, the facts asserted by the Examiner must be “capable of such instant and unquestionable demonstration as to defy dispute.” *MPEP 2144.03 citing In re Ahlert, 424 F.2d 1088, 1091 (citing In re Knapp Monarch Co., 296 F.2d 230, 132)*. Here the Examiner supports the assertion by stating that the use of guide pieces and trays having an arcuate surface to support the sheet of paper in an arcuate position is well known in the art as taught by Murakami. While Applicants disagree with this assertion, its accuracy is not relevant to whether or not having an arcuate support portion for supporting the sheet of paper in an arcuate punching position is critical to the punching operation. Furthermore, the criticality of the claim limitations is not relevant to patentability. Whether critical or not, the Examiner must cite prior art that teaches or suggests each and every claimed limitation. *See MPEP §2142*. Taking Official notice that a limitation is not critical does not relieve the Examiner of this burden.

Furthermore, Applicants respectfully point out that the specification does describe a problem that is solved by including the arcuate portion. Specifically, the arcuate portion, among other things, “serves to stiffen a workpiece with respect to a vertical axis by providing a slight bow or curvature along [a] portion of the workpiece adjacent [the] arcuate central portion.” *Specification, page 22, paragraph 73*. Thus, the Examiner’s statement that no stated problem is solved by the arcuate portion is incorrect.

In light of the foregoing, Otsuka, Murakami, and the Official notice taken by the Examiner, alone or in combination, do not teach or suggest each and every limitation of claim



8. As such, claim 8 is allowable. In addition, claims 9-13, which depend from claim 8 are allowable for these and other reasons.

### **CONCLUSION**

In light of the foregoing, Applicants respectfully submit that Claims 8-13, 30-36, and 38-43 are allowable. In addition, Applicants respectfully request that withdrawn claims 1-7, 14-29, and 37 be reinstated and examined.

The undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard L. Kaiser". The signature is fluid and cursive, with the first name "Richard" and last name "Kaiser" clearly distinguishable.

Richard L. Kaiser  
Reg. No. 46,158

Docket No.: 010398-9065-02  
Michael Best & Friedrich LLP  
100 East Wisconsin Avenue  
Milwaukee, Wisconsin 53202-4108

(414) 271-6560